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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

#11
BPA
10/15/3

IN RE APPLICATION OF :

FLORENCE L'ALLORET :

EXAMINER: EGWIM, K. C.

SERIAL NO: 10/069,983 :

FILED: MARCH 14, 2002 :

GROUP ART UNIT: 1713

FOR: FOAMING EMULSIONS AND :
FOAMING COMPOSITIONS
CONTAINING A POLYMER
COMPRISING WATER-SOLUBLE UNITS
AND UNITS WITH AN LCST,
ESPECIALLY FOR COSMETIC USES

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OCT 09 2003

TC 1700

RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Office Action dated August 8, 2003, Applicants elect, with traverse,
Group I, Claims 44 to 49.

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

The Office has required restriction in the present application as follows:

- Group I: Claims 44-49, drawn to the use of a polymer comprising water-soluble Units and units with a low critical solution temperature (LCST) to lower the tension of water;
- Group II: Claims 50-65, drawn to a foaming composition comprising a polymer comprising water-soluble units and units with a low critical solution Temperature (LCST);
- Group III: Claims 66-99, drawn to an oil-in-water emulsion comprising the foaming composition of group II; and
- Group IV: Claims 100-103, drawn to the cosmetic use of the foaming composition of group II.

Applicants elect, with traverse, Group I, Claims 44 to 49, with traverse.

The Examiner, citing PCT Rule 13.1 and 13.2, contends that the Groups do not relate to a single general inventive concept because they lack the same or corresponding special technical features. Specifically, the Office argues that the application lacks unity of invention since the polymer comprising water-soluble units with a low critical temperature "at least, is anticipated by or obvious over several prior art documents, including EP 583814 and EP 629649" referencing page 1 of the Applicants' specification (see page 2 of the Office Action). However, this rationale has no basis. The references do not describe specifically selecting a polymer with an LCST having in water a demixing temperature of from 5 to 40°C at a concentration of 1% by mass in water, for example, to lower the surface tension or the interface tension of water (see Claim 44). In fact, the International Examining authority deemed that the invention "appears to be novel and to involve an inventive step" (International Examination Report of January 24, 2003).

Applicants further traverse the Restriction Requirement on the ground that the Office has not applied the same standard of unity of invention as the International Preliminary

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Examination Authority. The Authority did not take the position that unity of invention was lacking in the international application and examined all claims together. Applicants note that PCT Article 27(1) states that no national law shall require compliance with requirement relating to the form and contents of the international application different from or additional to those which are provided for the Patent Cooperation Treaty and the Regulations. In light of PCT Article 27(1) and 37 C.F.R. §145 and §1.499, it is apparent that when the International Preliminary Examination Authority finds no objection based on lack of unity of invention, there is a special burden on the Office to explain why its conclusions are diametrically opposed to those of the International Preliminary Authority, as approved by treaty. The Office has not fulfilled this burden.

Moreover, the MPEP in §803 states as follows:

“If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together.

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In view of the above, Applicants request that the Restriction Requirement be withdrawn. Applicants further request examination on the merits.

Respectfully submitted,

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Docket No. 220759US0PCT

IN RE APPLICATION OF: Florence L'ALLORET

SERIAL NO: 10/069,983

FILED: March 14, 2002

FOR: FOAMING EMULSIONS AND FOAMING COMPOSITIONS CONTAINING A POLYMER COMPRISING WATER-SOLUBLE UNITS AND UNITS WITH AN LCST, ESPECIALLY FOR COSMETIC USES

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Transmitted herewith is an amendment in the above-identified application.

☒ No additional fee is required

☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 is claimed.

☒ Additional documents filed herewith: Request for Extension of Time (One-Month)

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The Fee has been calculated as shown below:

CLAIMS	CLAIMS REMAINING		HIGHEST NUMBER PREVIOUSLY PAID	NO. EXTRA CLAIMS	RATE	CALCULATIONS
TOTAL	60	MINUS	60	0	x \$18 =	\$0.00
INDEPENDENT	7	MINUS	7	0	x \$86 =	\$0.00
		<input type="checkbox"/> MULTIPLE DEPENDENT CLAIMS			+ \$290 =	\$0.00
		TOTAL OF ABOVE CALCULATIONS				\$0.00
		<input type="checkbox"/> Reduction by 50% for filing by Small Entity				\$0.00
		<input type="checkbox"/> Recordation of Assignment			+ \$40 =	\$0.00
		TOTAL				\$0.00

☒ A check in the amount of **\$110.00** is attached.

☐ Credit card payment form is attached to cover the fees in the amount of **\$0.00**

☒ Please charge any additional Fees for the papers being filed herewith and for which no check or credit card payment is enclosed herewith, or credit any overpayment to deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.

☒ If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time may be charged to Deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.

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